



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,035	06/28/2001	Michael Bacntsch	CH920000039US1 (14665)	5498

7590 10/06/2006

Steven Fischman, Scully,
Scott, Murphy & Presser
400 Garden City Plaza
Garden City, NY 11530

EXAMINER

SIDDIQI, MOHAMMAD A

ART UNIT	PAPER NUMBER
----------	--------------

2154

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/894,035	Applicant(s) BAENTSCH ET AL.	
	Examiner Mohammad A. Siddiqi	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-13 and 15-19 are presented for examination. Claim 14 has been cancelled.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1-13 and 15-19 rejected under 35 U.S.C. 102(a/e) as being anticipated by Waldin et al. (6,052,531) (Hereinafter Waldin).
4. As per claim 1, 9, 15, and 18, Waldin discloses computer-implemented method and code amendment enabler for a software provider (25) of enabling a software-acquiring entity (20) to arrive from an existent first signed piece of code (11) at a second signed piece of code (12, 13), both

pieces of code (11, 12, 13) having been generated by use of a first software archive generator (2) under use of generation instructions (8) comprising the step of:

providing to said software-acquiring entity (20) a difference code (4, 5) (software publisher provides update patches, col 2, line 66 - col 3 line 21), said difference code comprising the steps necessary to arrive from said first signed piece of code (11) at said second signed piece of code (12, 13), which difference code (4, 5) is usable at said software-acquiring entity (20) (software publisher provides update patches, fig 1, col 2, line 66 - col 3 line 21; col 4, lines 1-53); and

combining said difference code (update patches, col 4, lines 1-53) with said first signed piece of code (11) by a second software archive generator (7) to generate said second signed piece of code (12, 13) (JAR, col 4, lines 1-53), whereby said second software archive generator (7) is fed with those generation instructions (8) that were used by said first software archive generator (2) for the generation of both pieces of code (11, 12, 13) (fig 1, JAR, col 4, lines 1-53).

5. As per claims 2, 10, and 17, Waldin discloses wherein the generation instructions (8) are provided to the software-acquiring entity (20) by the software provider (25), together with the second software archive generator

(7) (software publisher provides update patches, fig 1, col 2, line 66 - col 3 line 21; col 4, lines 1-53, JAR).

6. As per claims 3 and 11, Waldin discloses wherein the pieces of code (11, 12, 13) are signed using a private key (14) (digitally signed, fig 1, col 2, line 66 - col 3 line 21; col 4, lines 1-53).

7. As per claim 4, Waldin discloses wherein the signed pieces of code (11, 12, 13) are stored in a storage unit (1) at the software provider (25) (fig 1, digitally signed, col 4, lines 1-53).

8. As per claim 5, Waldin discloses wherein the difference code (4, 5) is created, by the first software archive generator (2), while said first software archive generator (2) generates the second signed piece of code (12, 13) (fig 7-8B).

9. As per claim 6, Waldin discloses wherein for more than two pieces of code (11, 12, 3) being stored, the difference code (4, 5) is generated only between a subset of said pieces of code (11, 12, 13) (fig 1-6, col 2, line 66 - col 3 line 21; col 4, lines 1-53, col 9-10).

10. As per claim 7, Waldin discloses wherein for arriving from the first piece of code (11) to the second piece of code (13) several difference codes (4, 5) are required, these difference codes (4, 5) are merged to a single difference code to be provided to the software-acquiring entity (20) (fig 2-5, update patches, fig 1, col 2, line 66 - col 3 line 21; col 4, lines 1-53, JAR).

11. As per claims 8 and 12, Waldin discloses wherein the first and second piece of code (11, 12, 13) are identified at the software provider (25) by deriving a corresponding identifier from a request (16) received from the software-acquiring entity (20) (update patches, fig 1, col 2, line 66 - col 3 line 21; col 4, lines 1-53).

13. As per claim 13, claim is rejected for the same reasons as claim 1, above.

12. As per claim 16, Waldin discloses an input unit (24) for receiving from said software-acquiring entity (20) a code amendment request (16) for the delivery of said difference code (4, 5) (fig 8B).

13. As per claim 17, Waldin discloses a first software archive generator (2) for generating said pieces of code (11, 12, 13) under use of generation

instructions (8) (update patches, fig 1, col 2, line 66 - col 3 line 21; col 4, lines 1-53).

14. As per claim 19, Waldin discloses an input/output unit (6) for sending a code amendment request (16) to said software provider (25) and for receiving said difference code (4, 5) (fig 8A-8B).

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US 2002/0116477

US 2002/0038308


16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad A. Siddiqi whose telephone number is (571) 272-3976. The examiner can normally be reached on Monday -Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on (571) 272-

3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MAS

 JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100